

REMARKS

This paper is filed in response to the final office action mailed on June 8, 2005. Claims 2-3 and 11-12 were canceled in the previous amendment; claims 1, 4, 10, 13, 16 and have been amended; claims 1, 4-7, 10 and 13-19 remain pending.

Applicants respectfully submit that this amendment is in full compliance with Rule 116 because it raises no new issues, does not increase the total number of pending claims and places all claims in a condition for allowance.

The drawings are objected to as Fig. 2 of the formal drawings failed to include the reference numeral 19 for the spring tip. In response, a replacement sheet 1/3 is attached hereto as an appendix to traverse this objection.

The office action objects to the wording of claims 1 and 16 and claims 1 and 16 has been amended to traverse this objection.

Turning to the rejections based upon the prior art, the final office action rejects claim 1 under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 6,077,230 ("Gregoire"). In response, claim 1 has been amended to traverse this rejection.

Under MPEP § 2131,

[t]o anticipate a claim, the reference must teach every element of the claim. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

Citing, Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Gregoire fails to serve as an anticipating reference because it does not teach or suggest a tubular sheath with two axially spaced apart openings therein. Instead, the Gregoire sheath 45 includes circumferentially spaced openings 57 which are not axially spaced apart and therefore cannot be used as a device for taking two pressure readings on either side of an occlusion 12 without the tubular sheath 16. Claim 1 provides a structure where two pressure readings may be taken on either side of an occlusion 12 by simply moving the inner elongated tubular member 21 from a position where its sidewall opening 22 is aligned with the distal opening 18 of the tubular sheath 16 to the other side of the occlusion 12 where the opening 22 is aligned with the proximal opening 17 in the tubular sheath 16 as shown in Figs. 1 and 2 of the drawings as filed. Simply put, Gregoire fails to teach or suggest axially spaced apart openings and therefore Gregoire cannot teach or suggest a pressure sensing

device which is capable of measuring pressures at two distinct spots in a vascular system without moving the outer sheath.

Claim 1 also recites that its elongated tubular member includes a single sidewall opening and therefore Gregoire cannot anticipate amended claim 1 for this additional reason as the Gregoire structure 65 includes the opening 70 as well as vacuum openings 75.

Accordingly, Gregoire fails to teach or suggest every element of amended claim 1 and therefore cannot serve as an anticipating reference under § 2131 and the anticipation rejection of amended claim 1 is respectfully traversed.

Next, the office action rejects all pending claims under 35 U.S.C. § 103 as allegedly being obvious in view of U.S. Patent No. 4,168,703 ("Kenigsberg"). No interpretation of Kenigsberg can be used to establish a *prima facie* case of obviousness. Specifically, under MPEP §§ 2142 and 2143,

[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

Citing, In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *see also* MPEP § 2143-§ 2143.03 for decisions pertinent to each of these criteria.

In formulating this rejection, the Patent Office relies upon certain statements in Kenigsberg that indicate that the open ends 24, 14 of its inner tube 22 and outer tube or sheath 12, respectively, *may* be closed. However, nowhere in Kenigsberg is it indicated that the end 14 of the outer tube 12 can be closed. At column 3, line 31, Kenigsberg clearly states that the end 14 of the sleeve 12 is open. He also states that end 24 of the inner tube 20 is open at column 4, line 59. As an alternative, Kenigsberg states that the "end 24 is preferably open, although an opening could be alternatively provided adjacent thereto" at column 3, lines 22-24. Thus, Kenigsberg does state that the inner tube 22 may have a closed end 24 but he does not make such a statement with respect to the open end 14 of the sheath 12.

Kenigsberg then states that the separate tubular member 32 may include a closed end 34 at column 3, line 67 to column 4, line 2. Then, as also relied upon by the Patent Office, Kenigsberg states that the separate tubular member 38 may also include a closed end 40 at column 4, lines 15-19.

However, the Patent Office cites Kenigsberg for the proposition that it teaches an outer tube 12 through which an inner tube 22 can be axially moved. The outer tube 12 includes a plurality of openings shown at 20 in Fig. 1 and Fig. 2. As noted above, while Kenigsberg states that the inner tube 22 may include a closed end 24 if it has an opening disposed near that closed end 24, Kenigsberg never states that the outer tube or sheath 12 can include a closed end 14. Applicants respectfully submit that the Patent Office has read Kenigsberg too broadly as Kenigsberg does not propose a closed end 14 as an alternative to the open end 14 of the sheath 12 as shown in Fig. 1 of Kenigsberg.

Therefore, Kenigsberg fails to teach or suggest an elongated tube with a closed distal end as required by independent claims 1, 10 and 16 and, accordingly, no *prima facie* case of obviousness has been established.

Further, by failing to teach a closed distal end 14 for its sheath 12, Kenigsberg fails to teach or suggest a structure that would be suitable for movement within a vascular system. Specifically, the open distal end 14 of the Kenigsberg design is unsatisfactory for serving as an outer sheath in a vascular environment. Movement of the open distal end 14 could cause substantial trauma to the patient. Independent claims 1, 10 and 16 require a closed end which is more suitable for movement within a vascular system.

Instead, Kenigsberg is directed toward a gastroesophageal reflux diagnostic tool with three non-coaxial tubes 12, 32, 38 bound together and which is not designed for use in a vascular system. Accordingly, for at least these reasons, the obviousness rejection of claims 1, 4-5, 10, 13 and 15-17 based on Kenigsberg is improper and should be withdrawn.

An early indicating the allowability of this application and all pending claims is earnestly solicited.

The Commissioner is authorized to charge any fee deficiency required by this paper, or credit any overpayment, to Deposit Account No. 13-2855.

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Respectfully submitted,

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Attachment

APPENDIX

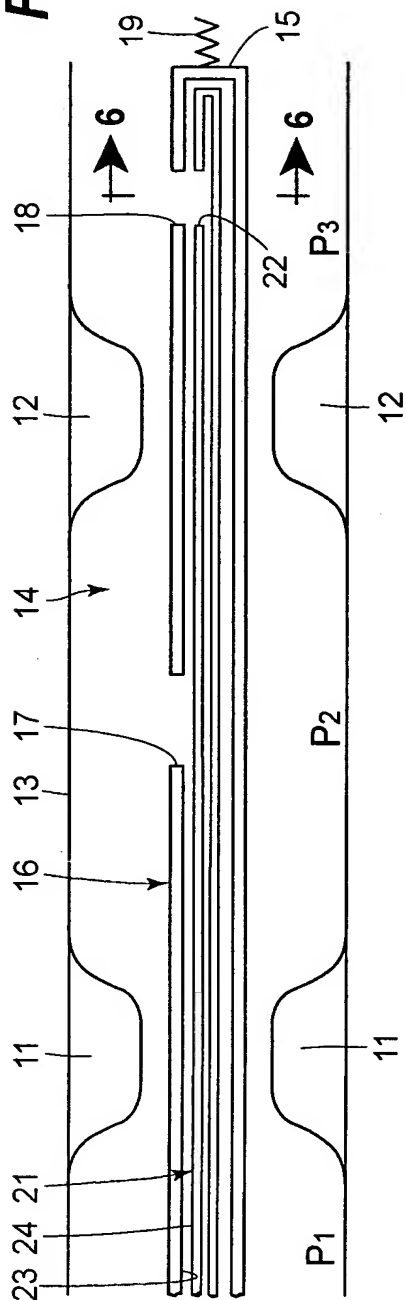


FIG. 2

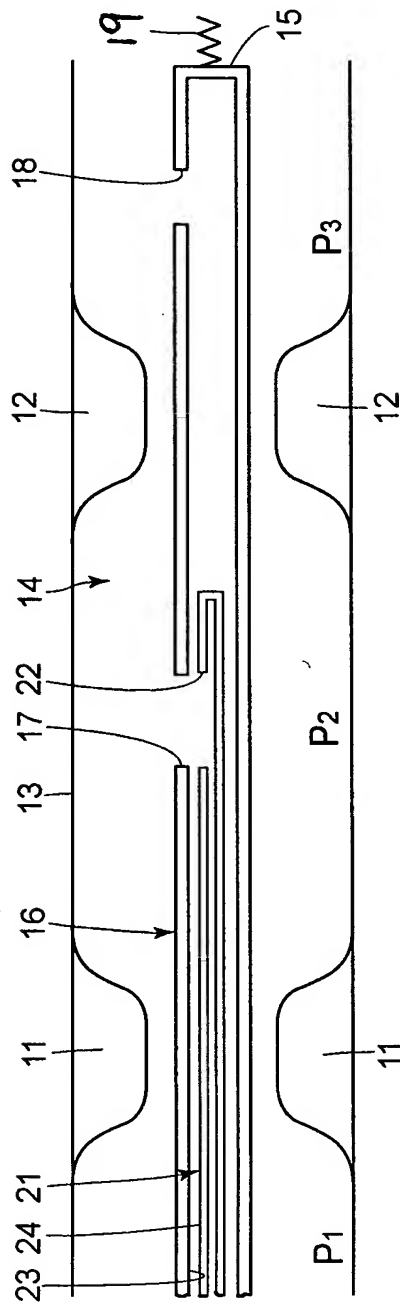


FIG. 3

